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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,686	10/13/2003	Zhou Ye	021756-002800US	3409
51206	7590	04/03/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			D AGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/684,686	YE ET AL.
	Examiner Stephen M. D'Agosta	Art Unit 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 March 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6,10-13,15,16,18-24,26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-5,10-13,15,16,18-20 and 30-34 is/are allowed.
- 6) Claim(s) 6,21,23,24,26,28 and 29 is/are rejected.
- 7) Claim(s) 22, 35-36 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Response to Amendment***

The examiner has provided a new Non-Final Office Action below.

1. While the applicant remarks that claim 6 has been incorporated with it's dependent (and convening) claims. Claim 6 did not incorporate claim 5.

Claim 5 is required since it states that the presence information for the recipient is determined (eg. by the method). The currently amended claim 6 is missing this limitation and thus is missing a step (a USC 112 rejection has been put forth). A more favorable outcome may occur if the claim incorporates this limitation.

2. Claims 21 and 26 do not require a user to be associated with multiple devices (eg. it states, in the alternative form, a user being associated with one OR more devices). The examiner notes that if a user is only associated with just "one" device, the claim merely recites a typical routed network (eg. there is no need to determine which user device to send the message to since they only have one device). A more favorable outcome may occur if the claim specifically states the user is associated with more than one device.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s) are: "determining presence information for the recipient". Since claim 6 states that "wherein the device type is determined based on presence information that indicates a device for the device type is active", there must be a preceding step which states that the presence information is determined (as was stated in claim 5).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 21, 23-24, 26 and 28-29** rejected under 35 U.S.C. 103(a) as being unpatentable over Fortman US6,594,349 and further in view of Tunnicliffe US6,055,240.

As per claims 21 and 26, Fortman teaches a system for sending messages (title, abstract) comprising:

a plurality of users, each user associated with one ~~or more~~ device types; (figure 1 shows a network supporting multiple users with one device type/address. Also see figure1, figure 6, #6100, C2, L10-28. See C5, L35 to C6, L30),

a message router configured to route messages from a first user to a second user (figure 1 shows the network components/gateways/routers/switches that route voice/data messages. Figure 3 shows an ADSI Translator),

the message router comprising:

a receiver configured to receive a message from the first user (figure 1 shows GSM phone, which is data message capable, and can connect to other GSM phones to send SMS/email messages. The phone can also support email and connect to other email users and/or the Internet, as is well known in the art);

an identifier module configured determine a user identifier for the second user for the message, the user identifier usable to determine device types that are associated with the second user (figure 6, #6400-6500 teaches translating a received call/message into the recipient's format which inherently requires the server to determine who the recipient is);

a sender configured to send the message to a device identifier associated with the determined device type for the second user (figure 6, #6600).;

**but is silent on** a device determiner configured to determine a device type ~~in the plurality of device types~~ associated with the second user, the device type determined using the identifier

wherein a message is generated by a first device that communicates in a first protocol and received in a second protocol by a second device that communicates in the second protocol.

Tunnicliffe teaches a message management system (title) which can translate caller messages into a format that can be received by a recipient (abstract, figures 1 and 3, and C4, L50 to C5, L38). Tunnicliffe also teaches the “system agent” being able to be programmed with (and or learn) preferences about the sender and receiver. He specifically states:

“information about the receiver’s preferences, for example, who the receiver is, how they operate and what equipment they use. For example, the agent may have information that receiver Andrew prefers to read email messages at 9am each day and that he has no fax machine”. (C6, L27-52, specifically L34-39)

The primary examiner interprets Tunnicliffe’s teachings as reading on the recipient being associated with one device (or more) (and being able to determine them) since he discloses that the system can identify one person (eg. Andrew) with one or more devices/machines and how/when to send the message (eg. send email, don’t send a fax). One skilled therefore realizes, if Andrew has a mobile phone, the system will send him a voice-type message after 9am. Other variations are certainly possible (eg. how/when to send to Andrew if he has email, voice, video, fax, chat, SMS, etc. capabilities).

The claim states that a recipient ID is used to determine a plurality of device types that are associated with the recipient. As stated above, Tunnicliffe receives a message and can determine how to route the message, eg. to which user device, based on either user preference and/or to a device the user possesses (C6, L54-63). It is the examiner’s position that Fortman system can support a plurality of users and that Tunnicliffe’s system can determine, from the message, a means by which to route the message to a specific user device.

As per **claim 23**, Fortman teaches claim 21, further comprising a formatter configured to format the received message to a format compatible with the determined device (figures 3-5 teach an interim device that receives the sender's message in a first protocol/format and translates into second protocol/format when sending to recipient).

As per **claim 24**, Fortman teaches claim 21 **but is silent on** further comprising a database configured to store information for one or more device types associated with the plurality of users.

Tunnicliffe teaches a message management system (title) which can translate caller messages into a format that can be received by a recipient (abstract, figures 1 and 3, and C4, L50 to C5, L38). Tunnicliffe also teaches the "system agent" being able to be programmed with (and or learn) preferences about the sender and receiver. He specifically states:

"the preference mode of the subscriber operation (for example, this can be voice, text or whatever mode is preferred at a certain time and situation, such as driving to work from 8:30-9am)

"information about the receiver's preferences, for example, who the receiver is, how they operate and what equipment they use. For example, the agent may have information that receiver Andrew prefers to read email messages at 9am each day and that he has no fax machine". (C6, L27-52, specifically L30-39).

The primary examiner interprets Tunnicliffe's "preferences" as being stored in a computer database and accessed to determine routing procedures.

It would have been obvious to one skilled in the art at the time of the invention to modify Fortman, such that it comprises a database configured to store information for one or more devices associated with the plurality of users, to provide means for accessing preference data for optimal routing.

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As per claims 28-29, Fortman teaches claim 13/26, wherein the format comprises at least one of a short message system (SMS), email, instant message (IM), and voice message format (figure 5 and C4, L35-38, L55-65 and C5, L5-15).

### ***Allowable Subject Matter***

1. Claims 1-5, 10-13, 15-16, 18-24 and 30-34 are allowed.

2. Claims 22 and 35-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

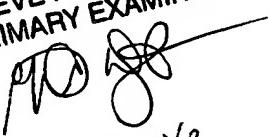
> Note that the independent claim requires the change from the alternative form (as discussed in the remarks section at the beginning of this Office Action).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEVE M. D'AGOSTA  
PRIMARY EXAMINER  
  
3-22-04